

REMARKS

This Amendment and Response are made in reply to the Office Action dated January 21, 2010, in which the Examiner:

objected to the drawings;

objected to the Abstract;

rejected claims 20-25 and 28-34 under 35 U.S.C. § 112, second paragraph, as indefinite;

rejected claims 20-25 and 28-34 under 35 U.S.C. § 102(a) as anticipated by German Utility Model No. DE 202 08 106 U1 by Danfoss Silicon Power GmbH (“the German Utility Model”); and

rejected claims 20-25 and 28-34 under 35 U.S.C. § 102(d) as anticipated by the German Utility Model.

Applicant respectfully addresses or traverses each of the rejections below. Claims 20-35 are pending. Claims 1-19 were previously cancelled. Claims 26, 27 and 35 were withdrawn following a Restriction/Election Requirement. Claims 20, 30, 31 and 32 are amended. Claim 20 is the lone independent claim.

Regarding the objection to the drawings, the Examiner has objected to the line quality of the drawings, and the fact that the drawings include reference numerals that are both handwritten and typed. (Office Action, page 2.)

Applicant respectfully disagrees with the Examiner, and submits that the quality of the lines in each of the drawings is durable, clean, black, sufficiently dense and dark, uniformly thick, and well-defined, with a weight that is sufficiently heavy to permit adequate reproduction. *See* 37 C.F.R. § 1.84(l). Moreover, Applicant knows of no prohibition on utilizing both handwritten and typed reference numerals in a patent submission. Accordingly, for the foregoing reasons, Applicant submits that the objections to the drawings are improper, and respectfully requests that they be withdrawn.

Regarding the objection to the Abstract, the Examiner objects to the language, format and content of the Abstract. (Office Action, pages 2-3.) As is set forth above, Applicant has amended the Abstract to conform with standard

rules of patent practice in the United States. *See* M.P.E.P. § 608.01(b). In view of the foregoing amendments, Applicant submits that the Examiner's objections to the Abstract have been properly addressed, and respectfully requests that they be withdrawn.

Regarding the rejections of claims 20-25 and 28-34 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner argues that claims 20, 30 and 31 fail to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. (Office Action, page 3.) Applicant submits that the foregoing amendments to claims 20, 30 and 31 clearly and distinctly set forth the subject matter claimed by the Examiner, and have adequately addressed the Examiner's rejections. Accordingly, in view of the foregoing amendments, Applicant respectfully requests that the rejections of claims 20-25 and 28-34 under 35 U.S.C. § 112, second paragraph, as indefinite be withdrawn.

Regarding the rejections of claims 20-25 and 28-34 under 35 U.S.C. § 102(a) as anticipated by the German Utility Model, the Examiner simply notes, in a single sentence, that the German Utility Model "discloses the fluid-coolable unit essentially as claimed," and that claims 20-25 and 28-34 are anticipated thereby. (Office Action, page 4.) Applicant respectfully disagrees with the Examiner.

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim.

Applicant respectfully submits that the Examiner has failed to establish that each element cited in claims 20-25 and 28-34 is shown or disclosed in the German Utility Model. The Office Action merely states that the German Utility Model discloses the unit "essentially as claimed" (Office Action, page 4), but does not identify any particular features in the German Utility Model that correspond to any of the elements recited in claims 20-25 or 28-34. Specifically, the Office Action fails to demonstrate that each and every element recited in independent claim 20, or any other claim depending therefrom, is found, either expressly or inherently described, in the German Utility Model, shown in as complete detail

as is contained in the claim, and arranged as required by the claim, as is required in order to reject a claim as anticipated. *See* M.P.E.P. 2131.

Applicant respectfully submit that an anticipation rejection is improper unless it clearly specifies, on the record, a particular component in a cited reference that corresponds to each and every one of the elements of the claimed invention. Because the Examiner has neither identified features in the German Utility Model corresponding to each of the elements recited in claims 20-25 or 28-34, nor demonstrated how each of the elements recited in the claims is inherently present in the German Utility Model, Applicant submits that the rejections of claim 20-25 and 28-34 under 35 U.S.C. § 102(a) as anticipated by the German Utility Model are improper, and must be withdrawn, for at least this reason.

Regarding the rejections of claims 20-25 and 28-34 under 35 U.S.C. § 102(d), the Examiner has simply stated that the claims are barred by the German Utility Model, with no further support or clarification in support of the rejections. (Office Action, page 5.) However, this statement is not sufficient to reject claims 20-25 and 28-34 as anticipated by the German Utility Model, at least because it fails to demonstrate that each and every element recited in claims 20-25 and 28-34 is present within the German Utility Model, as discussed above with regard to the rejections under 35 U.S.C. § 102(a), and also because the statement fails to satisfy each of the four requirements of 35 U.S.C. § 102(d). *See* M.P.E.P. § 2135.01. Specifically, the Examiner has not demonstrated that claims 20-25 and 28-34 could have been presented in the German Utility Model, as is required in order for a reference to qualify as prior art under 35 U.S.C. § 102(d). *Id.* Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the rejections of claims 20-25 and 28-34 under 35 U.S.C. § 102(d) as anticipated by the German Utility Model are improper, and must be withdrawn.

Additionally, regarding the rejections of claims 20-25 and 28-34 under 35 U.S.C. §§ 102(a) and 102(d), Applicant notes that the Examiner has failed to provide a translation of the German Utility Model. *See* M.P.E.P. § 706.02 ("To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the

Application Serial No.: 10/577,140
Office Action dated: January 21, 2010
Response to Office Action dated: April 21, 2010

document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection.”)
Applicant further submits that the rejections of claims 20-25 and 28-34 must also be withdrawn at least because the Examiner failed to provide an English translation of the German Utility Model, and because the record is not clear as to the precise facts relied upon by the Examiner in support of the rejections.

As Applicant has addressed or traversed each and every objection and rejection raised by the Examiner in the outstanding Office Action, Applicant respectfully requests that the Examiner withdraw the present objections and rejections, and pass claims 20-25 and 28-34 to issue.

Applicant believes that no fees are due in connection with this Amendment and Response. If any fees are deemed necessary, Attorneys for Applicant hereby authorize the Commissioner to deduct such fees from our Deposit Account 13-0235.

Respectfully submitted

/Marina F. Cunningham/
Marina F. Cunningham
Registration No. 38,419
Attorney for Applicant

Customer No. 35301
MCCORMICK, PAULDING & HUBER, LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-3402
Tel.: (860) 549-5290